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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,170	03/16/2006	Yahoshua BARAK	7044-X07-067	3847

27317 7590 11/17/2009
Fleit Gibbons Gutman Bongini & Bianco PL
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SUITE 115
MIAMI, FL 33180

EXAMINER

KAVANAUGH, JOHN T

ART UNIT	PAPER NUMBER
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3728

MAIL DATE	DELIVERY MODE
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11/17/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/595,170	Applicant(s) BARAK, YAHOSHUA	
	Examiner /Ted Kavanaugh/	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 5-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/1/2009, 3/17/2008, 6/9/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Claims 5-8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 9-24-2009.
2. Applicant's election with traverse of Group I in the reply filed on 9-24-2009 is acknowledged. The traversal is on the ground(s) that both groups now contain the same special technical features such as the insole being created from a cast of the foot in plaster. This is not found persuasive because such a limitation in a product claim (group II) does not carry significant weight. In a product claim the method of making the product is not material to the proposed invention being claimed. Moreover, creating an insole created by a cast of the foot in plaster is not a special technical feature inasmuch as this has been taught in the prior art as evidenced in the rejection below.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4702255 (Schenk).

Art Unit: 3728

Schenkl teaches a method for creating an insole (orthotic) as claimed including creating a cast of the foot in plaster (see col. 4, lines 51-57 and col. 6, lines 44-51), creating a specially designed insert that covers the five metatarsal heads area of forefoot (see col. 6, line 58 to col. 7, line 18. Regarding claim 2, the insert has a size (see col. 6, lines 65-67) as claimed. The insole with the specially designed insert is inherently capable of fitting a plurality of standard shoe sizes inasmuch as it has all the structure and steps as claimed. With respect to the flexing the flexing is controlled by the amount of additional material is being provided; see col. 8, lines 3-62.

5. Claims 1,3-4 are rejected under 35 U.S.C. 102(b) as being anticipated by US 6745501 (Brown).

Brown teaches a method for creating an insole (orthotic) as claimed including creating a cast of the foot in plaster (see col. 9, lines 6-13), creating a specially designed insert that covers the five metatarsal heads area of forefoot (see col. 9, lines 17-35 and figures 12-14). The insole (orthotic) with the specially designed insert is inherently capable of fitting a plurality of standard shoe sizes inasmuch as it has all the structure and steps as claimed.

6. Claims 1,3-4 are rejected under 35 U.S.C. 102(b) as being anticipated by US 1901353 (Mitchie).

Mitchie teaches a method for creating an insole (arch supporting insole) as claimed including creating a cast of the foot in plaster (see page 2, lines 101-115), creating a specially designed insert (5) that covers the five metatarsal

Art Unit: 3728

heads area of forefoot (see page 3, lines 33-37). The insole with the specially designed insert is inherently capable of fitting a plurality of standard shoe sizes inasmuch as it has all the structure and steps as claimed.

7. Claims 1,3-4 are rejected under 35 U.S.C. 102(e) as being anticipated by US 7206718 (Cavanagh).

Cavanagh teaches a method for creating an insole as claimed including creating a cast of the foot in plaster (see col. 5, lines 24-30), creating a specially designed insert that covers the five metatarsal heads area of forefoot (see col. 3, lines 16-20, col. 7, lines 52-58, and col. 8, lines 18-21 and see figure 18). The insole with the specially designed insert is inherently capable of fitting a plurality of standard shoe sizes inasmuch as it has all the structure and steps as claimed.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. **Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including:**

-“The reply must present arguments pointing out the *specific* distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.”

--“A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.”

-Moreover, “The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06” MPEP 714.02. The “disclosure” includes the claims, the specification and the drawings.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (571) 273-8300 **(FORMAL FAXES ONLY)**. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (571) 272-4556. The examiner can normally be reached from 6AM - 4PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562.

If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (In United States OR CANADA) or 571-272-1000.

/Ted Kavanaugh/
Primary Examiner
Art Unit 3728

TK
November 17, 2009